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10/563,277

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Catherine Primard-Brisset

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,277	Applicant(s) PRIMARD-BRISSET ET AL.	
	Examiner David T. Fox	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40 is/are allowed.
- 6) ☒ Claim(s) 39,41,44,45 and 47 is/are rejected.
- 7) ☒ Claim(s) 37,38,42,43 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's Response

The amendment of 30 October 2009 has been entered-in-part. The specification amendments have not been entered for the reasons stated below. The amendments to the claims and Abstract have been entered.

Applicant's amendments of 30 October 2009 and accompanying arguments have overcome the objection to the specification for lacking an Abstract, the indefiniteness rejection of record, and the enablement rejection pertaining to the original source of the restorer gene.

Applicant's amendments to the specification, other than the amendment to add an Abstract, have not been entered because they do not comply with 37 CFR 1.121(b). In the last Office action, the Examiner suggested amendments to overcome his specification objections. For convenience, the Examiner presented these amendments in the format of an Examiner's Amendment. However, the format for specification amendments by Applicant is not the same format as Examiner's amendments to the specification, per 37 CFR 1.121(b). The Examiner had directed Applicant to Rule 121(b) on page 2 of the last Office action. Applicant is encouraged to resubmit the specification amendments in proper format.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Effective Filing Date

The Examiner erred when he stated on page 2 of the last Office action that the effective filing date of the instant application was the filing date of the foreign priority

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application. The effective filing date of the instant application is the filing date of the PCT application upon which it is based, namely 05 July 2004. The Examiner apologizes for the confusion.

Specification Objections

Informalities

The specification remains objected to for its lack of continuity data and headings, and for typographical errors, as stated on pages 3-4 of the last Office action. In addition, Applicant is requested to delete the material found in the first paragraph of the specification as originally filed, since this material is redundant in view of the newly submitted Abstract. The Examiner had requested such a deletion on page 2 of the last Office action, last sentence.

Sequences

The specification remains objected to for its omission of sequence identifiers following every recitation of sequences, as required by 37 CFR 1.821(d), as stated on page 4 of the last Office action, bottom paragraph. Although Applicant is not required to delete the redundant sequence recitations on page 3 of the specification, line 26 through page 4, line 8; Applicant *is* required to insert the corresponding sequence identifier next to each recited sequence at each occurrence.

Incorporation by Reference

The specification is objected to under 37 CFR 1.57 because it attempts to incorporate essential subject matter by reference to non-patent publications, as stated on pages 5-6 of the last Office action.

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Applicant's arguments filed 30 October 2009 have been fully considered but they are not persuasive. Applicant urges that they are not required to recite known sequences, per *Falko-Funter Falkner v. Inglis* (Fed. Cir. 2006). Applicant urges that the marker sequences SG129 and SG34 were known, as evidenced by their disclosure in Primard-Brisset (2005). See page 8 of the Response of 30 October 2009, bottom paragraph.

The Examiner maintains that different fact patterns exist between *Falko -Funter* and the instant application. First, in *Falko-Funter*, the issue was whether a prior-filed application provided sufficient description of a later-claimed invention, in order to award priority to the earlier filed application, for the purposes of determining the outcome of an interference proceeding.

Second, in *Falko-Funter*, at least some sequences corresponding to the claimed sequences were disclosed in the earlier applications, namely a complete viral vector sequence from at least one potyvirus. In the instant application, Applicant discloses two species, namely SG129 (also claimed) and SG34, without any sequence information. These species are distinct molecular markers that do not belong to any genus of conserved sequences, wherein no genus of conserved or related sequences were disclosed, and wherein no representative species (sequence) of any putative genus was disclosed.

Third, the prior art upon which Applicant now relies to demonstrate that the sequences were "known", namely Primard-Brisset et al (2005), was published *after* the

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effective filing date of the instant application. Such later-disclosed sequences were not “known” at the time of the invention.

Applicant may overcome this objection by deleting the recitation of SG129 in claim 41.

Claim Objections

Claims 37-38 and 42, and dependents, are objected to because of the following reasons. Applicant’s amendment of 30 October 2009 has introduced some inconsistencies and antecedent basis problems in claims 37 and 42. Moreover, the Examiner has noticed a typographical error in claim 38. The following claim amendments would obviate these informalities. Applicant is reminded that the following amendments are presented in the format of an Examiner’s amendment, but should be submitted by Applicant in the format specified by 37 CFR 1.121(c).

In claim 37, line 7, replace “lines” with ---line---.

In claim 37, line 8, replace “present” with ---presents---; and insert ---the--- before “five”.

In claim 38, line 4, insert ---a--- before “homozygote”.

In claim 42, line 3, replace “introgression” with ---insertion---.

Enablement

Source of Essential Claim Element

Claim 41 remains rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention, as stated on pages 7-8 of the last Office action.

Applicant's arguments filed 30 October 2009 have been fully considered but they are not persuasive. Applicant urges that the SG129 marker was known in the art at the time of the invention, as stated above. The Examiner has refuted this assertion, as stated above. Applicant should amend claim 41 as instructed above, in order to overcome this rejection.

Deposit

Claim 45 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as stated on pages 8-9 of the last Office action.

Applicant's arguments filed 30 October 2009 have been fully considered but they are not persuasive. Applicant urges that their amendment to claim 45 to recite the date and place of deposit has obviated the rejection, wherein the depository is recognized under the Budapest Treaty.

The Examiner maintains that this claim amendment is insufficient to overcome the rejection. The enablement rejection was based upon the uncertainty regarding public availability of the deposit, since the *conditions* of the deposit were unclear. Amending the claim to recite the date and location of the deposit does not address the issue of public availability or deposit conditions. Moreover, it is unclear whether the

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deposit was actually made under the Budapest Treaty, and even if it were, this fact alone would have been insufficient to demonstrate public availability and therefore enablement, as stated in the last Office action.

Applicant is again directed to the paragraph bridging pages 8 and 9 of the last Office action, and the first full paragraph of page 9 of the last Office action, which set forth suggested language for signed statements outlining the actual conditions and public availability of the deposit. Further claim amendments are not desired.

Anticipation

Claims 39, 44 and 47 remain rejected under 35 U.S.C. 102(b) as being anticipated by each of Delourme et al (1992) or Delourme et al (1999), as stated on pages 12-14 of the last Office action.

Applicant's arguments filed 30 October 2009 have been fully considered but they are not persuasive. Applicant urges that since these claims depend upon claims which were deemed free of the prior art, that these claims must be free of the prior art as well.

The Examiner maintains that the rejected claims are drawn to seeds of a *Brassica* plant, wherein said seeds are the result of crossing the patentable plant with an undisclosed second plant. If the undisclosed second plant did not contain the instantly claimed restorer gene insertion, then seeds "derived from" the claimed plant would not possess the patentable restorer gene fragment, as stated previously.

Applicant may overcome this rejection by amending each of claims 39, 44 and 47 to recite the following phrase before the period:

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--- , wherein said seeds comprise the *Rfo* insertion deleted of the radish *Pgi-2* allele and recombined with the *Pgi-2* gene from *Brassica oleracea*---

Applicant is reminded that this amendment is being provided in the format of an Examiner's Amendment, and not in the format of an amendment by Applicant.

Conclusion

Claims 37-38, 40-43 and 45-46 remain free of the prior art, for the reasons presented on page 14 of the last Office action.

Claims 39, 41, 44-45 and 47 are rejected.

Claims 37-38, 42-43 and 46 are objected to.

Claim 40 is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David T Fox/

Primary Examiner, Art Unit 1638

January 14, 2010